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HUGH P. GORTLER			PLUCINSKI, JAMESUE A	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/791,998
Filing Date: March 02, 2004
Appellant(s): NG ET AL.

Hugh P. Gortier
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 24, 2010 appealing from the Office action mailed September 2, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 27-33 are pending.

Claims 27-33 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

US 2004/0257225	WEBB	12-2004
US 2008/0117040	PEEL et al.	5-2008
US 2004/0182936	KOENICK et al.	9-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the appellant regards as his invention.

2. Claims 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.
3. With respect to Claims 32 and 33: The claims are directed towards a system, which is considered to be an apparatus claim, with structural elements. The claims contain structural limitations, however positively claim active method steps of “operating” and “switching”.

Therefore it is unclear to the examiner if this is a system claim or a method claim. The appellant suggests the wording "the CSU is configured to operate in a high power".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Webb, Sr. (US 2004/0257225).

6. With respect to Claim 27: Webb discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (See abstract) comprising:

- a. Means for determining geographic location of the cargo container during shipment from the origination point to the destination (Reference numerals 142, 241 with corresponding detailed descriptions and Paragraphs 0056 and 0057); and
- b. A battery-powered (paragraph 0069) container security unit (200) for the container, the CSU reporting on status of the cargo container during the shipment (Reference numerals 270, 237 and Paragraph 0068). Webb discloses reporting and transmitting the data periodically and transmits only within range of the satellite, (Paragraphs 0073, 0078, 0084 and 0098), however the reporting being done on a

frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPW2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Webb discloses all the structural limitations of the claim, therefore anticipates Claim 27.

7. Claims 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Peel et al. (Us 2008/0117040).
8. With respect to Claim 27: Peel discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (see abstract), the system comprising:
 - c. Means for determining geographic location of the cargo container during shipment from the origination point to the destination (See Reference numeral 100 with corresponding detailed description); and
 - d. A battery powered (paragraph 0120) container security unit for the container, the CSU reporting on status of the cargo container during the shipment (See Reference numerals 190 and Paragraphs 0046 and 0076). The reporting being done on a frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in which a

claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Peel discloses all the structural limitations of the claim, therefore anticipates Claim 27.

9. With respect to Claim 28: Peel discloses the use of a CSU bridge Reference numeral 180 with corresponding detailed description). With respect to the term “for extending range of the wireless network communication so the CSU can operate longer in a low-power wireless network mode”, what the CSU bridge is used for considered to be intended use of the CSU bridge. Peel discloses the CSU to be battery powered or solar powered, therefore due to the fact that the present invention considers battery powered to be a lower power environment, then the examiner considers the battery power CSU of Peel to be a low powered environment.

10. With respect to Claims 29 and 30: Peel discloses the Bridge being located on the ship which moves the cargo and communicates via satellite on the water, therefore attached to the moving cargo means and in a location where direct communication links are not available (See Figures 1 and 2 with corresponding detailed description).

11. With respect to Claim 31: Peel discloses, in paragraph 0053, there is two way communication between the CSU bridge and the CSU, therefore fully capable of providing information to the CSU, what that information is regarding, whether it be positional information or not, is considered to be intended use of the system. Systems are held to the structural limitations and the capabilities thereof and it has been held that a recitation with respect to the

manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPW2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peel et al. (Us 2008/0117040) in view of Koenck et al. (US 2004/0182936).

15. With respect to Claims 32 and 33: Peel discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (see abstract), the system comprising:

- e. A device for determining geographic location of the cargo container during shipment from the origination point to the destination (See Reference numeral 100 with corresponding detailed description); and
 - f. A battery powered (paragraph 0120) container security unit for the container, the CSU reporting on status of the cargo container during the shipment (See Reference numerals 190 and Paragraphs 0046 and 0076). The reporting being done on a frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Peel discloses all the structural limitations of the claim, therefore anticipates Claim 32.
16. Peel discloses the use of a CSU however fails to disclose the CSU operating in a high power and a lower power wireless state. Koenck discloses the use of a transmitter on a shipping container (see abstract and paragraph 0102), where the transmitter operates in both a high power setting and a low power wireless setting. The high power is used for long range transmissions, where the low power is used for close in transmissions (See Paragraphs 0044, 0047, 0077 and 0091). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Peel, to have the capability to communicate in both low power and high power based on location, as disclosed in Koenck, in order to provide an integrated

communication means which increases efficiency in data collection and improves the functionality of the transmitting/communicating means (See Koenck, Page 2).

(10) Response to Argument

With respect to Appellant's Argument I, Rejection of Claim 27 as being anticipated by Webb: The appellant is arguing that Webb does not disclose the frequency of reporting is a function of geographic location of a cargo container and discloses that the examiner has made a legal error by ignoring claim language. First it should be pointed out that the examiner did not ignore the claim language, the examiner considered and addressed every word in the above rejection, however the examiner considered the frequency of reporting to be intended use of the system as claimed. The appellant has stated that it is a functional feature that allows the container security to conserve power, however as written, the claim is a system claim, and states the reporting being a frequency of location, in a wherein clause, intending the system to function a certain way. Webb has the status being reported, therefore fully capable of the frequency being a function of location. The claim is directed towards a system claim, which is held to the structural limitations and the functionalities they provide (positively claimed) and what they are capable of providing. The system of Webb is fully capable of functioning as claimed in claim 27, therefore the claim is anticipated by Webb, as stated above.

The Appellant has also argued that the MPEP states that intended use issues are "typically" raised with respect to the preamble, however this explains where it is typically found, it does not state that it can only be found in the preamble. Furthermore, the examiner did not

ignore a single limitation, but addressed each limitation and considers Webb to be fully capable of performing the functions outlined in the claim.

With respect to Appellant's Argument II, Claims 27-31 being anticipated by Peel et al.:

The appellant is arguing the Peel reference for the same reasoning as above for Well. The claims are recited as a being a system claim, not a method claim. Therefore limitations on what the system is intended to be used for or often they intend to perform a step is considered to be intended use. The claim limitation is written in a wherein clause, the system of Peel reports information, the frequency of reporting is intended use. The appellant *does not* claim that the CSU is programmed to have the frequency of the reporting be a function of the geographic location, simply states that it is, which means as long as the prior art is capable of performing the step, then the limitation is met. The examiner considers Peel to be capable of performing this action due to the fact that Peel discloses a reporting step, as outlined in the rejection above.

It should be pointed out that the examiner did not ignore the claim language, the examiner considered and addressed every word in the above rejection, however the examiner considered the frequency of reporting to be intended use of the system as claimed. The appellant has stated that it is a functional feature that allows the container security to conserve power, however as written, the claim is a system claim, and states the reporting being a frequency of location, in a wherein clause, intending the system to function a certain way. Peel has the status being reported, therefore fully capable of the frequency being a function of location.

The Appellant has also argued that the MPEP states that intended use issues are "typically" raised with respect to the preamble, however this explains where it is typically found,

it does not state that it can only be found in the preamble. Furthermore, the examiner did not ignore a single limitation, but addressed each limitation and considers Webb to be fully capable of performing the functions outlined in the claim.

With respect to the Appellant's argument that Peel does not disclose the use of a bridge: As stated by the appellant the definition of a term can be given the broadest reasonable interpretation consistent with the specification. And as stated by the Appellant Peel discloses the bridge being located on the ship which moves the cargo containers, and this is acknowledged by the examiner in Claims 29 and 30. Peel also discloses that a radio tower is in communication with the bridge. The specification states in Paragraph 23 that the bridge can be and transceiver capable of communicating with the CSU in a wireless manner. The bridge of Peel is able to communicate in a wireless manner therefore the interpretation is consistent with the specification.

It should be pointed out that the claims as recited are very broad, the appellant is disclosing general structures and what they are used "for", and not positive statement of the structures being configured or programmed to perform specific functions.

With respect to Appellant's Argument III, 103 rejection with Peel in view of Koenick:

First the appellant states that Koenick does not disclose the frequency of reporting, however it should be noted that Koenick is not relied on for teaching this limitation, therefore argument is not persuasive. The appellant is arguing the combination of references stating the examiner has provided only a reason why to combine the references, but now how when combined this outcome would be accomplished, and therefore is a bald conclusion of obviousness. However

Koenick discloses transmitters operating on low and high power to increase efficiency. This is specifically pointed out in Koenick, the transmitters of Peel, if run in a low and high power state, would increase efficiency, just as the transmitters in Koenick, therefore the combination of references is proper and the examiner has provided more than a bald conclusion of obviousness.

With respect to Appellant's Argument IV, 112 2nd paragraph rejection: As stated by the appellant the primary purpose of the requirement for definiteness is to ensure the scope of the claim can be determined. The examiner has stated claims 32 and 33 were indefinite, because the appellant in the preamble has the claims being a system claim, which is a structural claim, and then claims the system components actively performing method steps. Therefore one could not ascertain whether the claims are directed towards a method or a system. Therefore one would not be able to determine the scope of the claim. In Claim 33 for instance the appellant has stated a security means for maintaining security, which is okay, however further in the claim it states that the security means is reporting, operating and switching, which are active method steps. Therefore are not part of the 112 6th limitation, but rather positive active method steps in a system claim.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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